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*APR 17*

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <b>P21432</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number <b>09/937,016</b>	Filed <b>22 January 2001</b>	
	First Named Inventor <b>Alain GANTIER</b>		
	Art Unit <b>3728</b>	Examiner <b>Jila MOHANDESI</b>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the  <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. <b>32,674</b> Registration number _____  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <b>James L. Rowland</b> Typed or printed name <b>703-716-1191</b> Telephone number <b>27 September 2006</b> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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U.S. Patent Application No. 09/937,016  
P21432.A17 (S 894/US/PCT)

PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Alain GANTIER	)	
			)	Group Art Unit 3728
Appln. No.	:	09/937,016	)	
			)	Examiner Jila Mohandesi
Docket No.	:	P21432	)	
			)	Confirmation No. 3081
Customer No.	:	07055	)	
			)	
I.A. Filed	:	January 22, 2001	)	
			)	
Title	:	MOVABLE COVER FOR RIGIDIFYING	)	
		AND/OR PROTECTING THE FRONT	)	
		FACE OF AN ARTICLE OF FOOTWEAR,	)	
		SUCH AS A SNOWBOARD BOOT	)	

**ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW**

USPTO Customer Service Window, ATTN: Mail Stop **AF**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicant requests review of the final rejection in the above-identified application, pursuant to the Official Gazette Notice published on July 12, 20005, entitled "New Pre-Appeal Brief Conference Pilot Program."

Being filed concurrently with the instant document are the following: (1) a completed and signed form PTO/SB/33, which form is entitled "Pre-Appeal Brief Request for Review;" (2) a Notice of Appeal in compliance with 37 CFR §41.31; (3) a Request for Extension of Time Under 37 CFR §1.136(a), the latter extending the shortened statutory period from the date of the final Office action to September 27, 2006; and (4) payment in the amount of \$1070.00, which includes the appeal fee of \$500.00 in compliance with 37 CFR §41.20, and the fee required to extend the shortened statutory period for reply for a third month.

The Commissioner is authorized to charge any fee required for timeliness and/or completeness to Deposit Account No. 19-0089.

## **STATUS OF CLAIMS AND REJECTIONS**

At the time of the filing of the instant Request for Pre-Appeal Brief Review, claims 14-44 and 47-64 are pending, with claims 14, 15, 29, 30, 44, and 58 being independent. This status is consistent with the Advisory Action mailed on September 14, 2006, which indicates that Applicant's amendment – included in their Reply Under 37 CFR §1.116 – would be entered for purposes of appeal.

Claims 29, 32-34, 42, and 53 stand rejected under 35 USC §103(a) as being unpatentable over PHILLIPS et al. (U.S. Patent No. 3,783,534, hereafter "PHILLIPS") in view of BOUGHEY (U.S. Design Patent No. 157,124). Claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 47-52, and 54-64 stand rejected under 35 USC §103(a) as being unpatentable over PHILLIPS in view of ELLIS et al. (U.S. Patent No. 3,206,874, hereafter "ELLIS") and BOUGHEY. Independent claim 24 is allowed.

## **ARGUMENTS**

### **A. Withdrawal of Rejection Based upon the Combination of PHILLIPS and BOUGHEY**

Applicant requests withdrawal of the rejection of claims 29, 32-34, 42, and 53 (claim 29 being the only independent claim), in view of the following.

#### **1. PHILLIPS Does Not Disclose a Rigid or Semi-Rigid Tongue that Covers the Flexion Fold and Extends Forwardly to the Front End Zone**

PHILLIPS discloses an off-road motorcycle boot intended to protect the cyclist's shin and lower leg against injury by being struck by items such as brush during trail riding. See, e.g., column 3, lines 34-39 of PHILLIPS.

To provide such protection (see column 2, lines 25-52), PHILLIPS equips his boot with rigid strips 42 and 43 (see Fig. 2) which are embedded between two layers of the sides 20 of the upper 14 of the boot, extending between the ankle and knee. In addition, PHILLIPS equips the tongue 30 of his boot with a rigid strip 40 between two layers of material which make up the tongue for protecting the shin (column 2, lines 39-40).

Near the bottom of page 2 of the Office action, the rejection includes the assertion that the cover of PHILLIPS is "more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal)" and, therefore, "it will inherently interfere with the free flexing of the shoe to some extent."

Applicant submits that this position is erroneous for reasons given in Section C.1., extending from page 17 to page 19 of Applicant's reply to the final Office action.

## **2. BOUGHEY Fails to Disclose a Shoe Cover Articulated Relative to the Sole**

Independent claim 29 (as well as independent claims 14, 15, 44, and 58, mentioned below in connection with the second ground of rejection) specifies that the cover is connected to the sole by being articulated thereto between the top and bottom of the sole.

In PHILLIPS, the tongue 30 is said to be “hingedly attached to the boot 10 near the toe 16” and that “[a]n extending portion of the tongue 30 is covered by a triangular metal plate<sup>32</sup> and secured to the boot by rivets 34” (see column 2, lines 13-16). As shown in the drawings, the rivets are atop the forefoot region of the upper. The cover is neither connected nor articulated to the sole.

The sentence bridging pages 2 and 3 of the final Office action admits that “Phillips does not disclose the cove being fixed to the sole between the top and bottom of the sole for articulation relative to the sole.”

Therefore, BOUGHEY is newly relied upon in the final rejection, the rejection stating that “Boughey ‘124 discloses a shoe and a cover for flexural stiffening of the shoe where the cover is fixed between the top and bottom of the sole for better articulation relative to the sole” (page 3, lines 2-4 of the Office action).

Applicant submits that this position is erroneous for reasons given in Section C.2., extending from page 19 to page 21 of Applicant’s reply to the final Office action.

Furthermore, a position – advanced for the first time during the over three years of prosecution of the instant application – in the Continuation Sheet of the Advisory Action of September 14, 2006, is that the word “articulate” means “to unite or connect by or as if by a joint” and, consequently, that “the cover of Boughey is connected to the sole *regardless of if it articulates movement with respect to the sole of the shoe or not*” (emphasis added), is erroneous. In construing a claim limitation, Applicant submits that the limitation should be read in light of the specification, rather than without regard thereto.

## **3. BOUGHEY Fails to Disclose a Shoe Cover for Flexural Stiffening of the Shoe**

As mentioned above, the rejection explains that “Boughey ‘124 discloses a shoe and a cover for flexural stiffening of the shoe ...” (page 3, line 2 of the Office action).

Applicant submits that this position is erroneous for reasons given in Section C.3., presented on page 21 of Applicant’s reply to the final Office action.

## **4. Modifying PHILLIPS by Means of BOUGHEY Would be Contrary to PHILLIP’s Disclosure**

Further, even if BOUGHEY were to have provided a description of articulated movement relative to the sole of a shoe, one skilled in the art would not have been motivated to modify the

boot of PHILLIPS in a way that would have resulted in Applicant's invention, for reasons given in Section C.4., on pages 21-22 of Applicant's reply to the final Office action.

**B. Withdrawal of Rejection Based upon the Combination of PHILLIPS, ELLIS, and BOUGHEY**

Applicant requests withdrawal of the rejection of claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 47-52, and 54-64 (claims 14, 15, 30, 44, and 58 being independent), in view of the following.

In short, the rejection is believed to be erroneous at least for reasons advanced above in connection with the rejection based upon PHILLIPS and BOUGHEY.

**1. PHILLIPS Does Not Disclose a Rigid or Semi-Rigid Tongue that Covers the Flexion Fold and Extends Forwardly to the Front End Zone**

As mentioned above, PHILLIPS does not teach or suggest that the tongue 30, identified in the Office action as a "protective cover," extends down to the flexion fold zone, nor to the front end zone and, therefore, the rejection is erroneous for this reason. Instead, because of the need to allow freedom of movement, as explained in Section D.1. on pages 22-23 of Applicant's reply to the final Office action, the lower edges of the rigid strips 40, 42, 43 are above the ankle. In contrast, independent claims 14, 15, 30, 44, and 58 call for the cover "within said flexion fold zone"; "extend ... through a flexion fold zone"; "covering said flexion fold zone"; "cover said flexion fold zone"; and "extending ... in said flexion fold zone."

**2. BOUGHEY Fails to Disclose a Shoe Cover Articulated Relative to the Sole**

Independent claims 14, 15, 44, and 58, like independent claim 29 discussed above, as well as dependent claims 63 and 64, specify that the cover is connected to the sole by being articulated thereto between the top and bottom of the sole.

In PHILLIPS, the tongue 30 attached to the top of the forefoot of the upper. Therefore, reliance is had on BOUGHEY. However, as explained above, BOUGHEY's "foot shield" is not articulated to a shoe.

**3. BOUGHEY Fails to Disclose a Shoe Cover for Flexural Stiffening of the Shoe**

The rejection explains that "Boughey '124 discloses a shoe and a cover for flexural stiffening of the shoe ..." (page 4, lines 3-4 of the Office action).

As mentioned in Section D.3. of Applicant's reply to the final Office action, in connection with the rejection of independent claim 29, although BOUGHEY entitles his design a "foot shield body," there is no disclosure of it covering a flexion zone of a shoe. On the contrary, the foot shield merely lies atop the forefoot and toward the instep.

**4. Modifying PHILLIPS by Means of BOUGHEY Would be Contrary to  
PHILLIP's Disclosure**

Further, even if BOUGHEY were to have provided a description of articulated movement relative to the sole of a shoe, one skilled in the art would not have been motivated to have modified the boot of PHILLIPS in a way that would have resulted in Applicant's invention, for reasons explained in Section D.4. on page 24 of Applicant's reply to the final Office action.

**5. None of PHILLIPS, ELLIS, and BOUGHEY Teach or Suggest the Subject  
Matter of Claim 30**

Independent claim 30 specifies that the cover comprises a continuous rigid or semi-rigid material that extends continuously from within the upper part of the cover, through the intermediate part, and within the lower part. In addition, claim 30 specifies that the lower part of the cover is then connected to the sole, so that the wearer of the boot can transmit forces from his/her lower leg to the sole of the boot. None of PHILLIPS, ELLIS, and BOUGHEY, nor any reasonable combination of PHILLIPS, ELLIS, and BOUGHEY teach or suggest the subject matter of claim 30, for reasons given in Section D.5. on pages 24-25 of Applicant's reply to the final Office action.

**6. None of PHILLIPS, ELLIS, and BOUGHEY Teach or Suggest the Subject  
Matter of Dependent Claims 27, 43, and 48**

In dependent claims 27, 43, and 48 Applicant calls for a plurality of covers having different rigidities. The rejection references column 3, lines 2-6 of ELLIS as suggesting this additional feature of the claimed invention, on the theory that it amounts to "mere duplication of the essential working parts of a device" which "involves only routine skill in the art." The rejection then references *St. Regis Paper Co. v. Bemis Co.*, 198 USPQ 8 (7<sup>th</sup> Cir.). Applicant submits that this position is erroneous for reasons given in Section D.6., on page 25 of their reply to the final Office action.

**SUMMARY AND CONCLUSION**

Reconsideration and withdrawal of the rejections are kindly requested for reasons given above. The Examiner is invited to contact Applicant's undersigned representative at the telephone number, fax number, or e-mail address which appear below for any comment or question.

Respectfully submitted,  
Alain GANTIER

  
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September 27, 2006  
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